

DRAWING AMENDMENTS

The applicant respectfully submits an Attachment 1 to highlight the two sidewalls of the connector extending in an inclined manner in the Figure 3 as claimed in claim 4.

REMARKS-General

The claims 2-21 are amended to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

The applicant respectfully submits Attachment 1 and Attachment 2 that the Attachment 1 shows the two sidewalls of the connector extending in an inclined manner and Attachment 2 illustrates the structural differences between the instant invention and cited arts.

Response to Rejection of Claims 2-21 under 35USC112

The applicant submits that the amended claims 2-21 particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112.

Regarding to Rejection of Claims 2, 3, 5, 6, 9, 10, 12, 13 and 19 under 35USC102

The Examiner rejected claims 2, 3, 5, 6, 9, 10, 12, 13 and 19 as being anticipated by JP2001-165437. However, the JP2001-165437 and the instant invention are not the same invention according to the fact that the JP2001-165437 does not read upon the instant invention and the newly independent claim 2 of the instant invention does not read upon the JP2001-165437 too. Apparently, the instant invention, which discloses a lighter wherein the connecting means is hidden in the case side edge to pivotally connect the upper cover with the case, should not be the same invention as the JP2001-165437 which discloses a hinge structure to pivotally connect the upper case with the lower case.

As disclosed in JP2001-165437, the main objective of the cited art is to provide "a fixing means for a hinge member, which is useful especially for a lighter case material in which a welding of metal hinge member is impossible to a resin of a portable lighter case, in which a fuel tank and an ignition part are integrated with each other". However, the objective of the instant invention is to provide a pivot hinge pivotally connecting the upper cover with the case, wherein the pivot hinge (connecting means) is protected by the upper cover since the pivot hinge is hidden in the case.

According to JP2001-165437, as shown in Figs. 8 and 11, it is clearly disclosed that the two sheet members are inserted in the hinge-insertion grooves formed respectively in the upper and lower case, wherein the pivot hinge is positioned between the upper and lower cases and exposed at an exterior of the lighter case. Therefore, JP2001-165437 fails to anticipate the instant invention of claim 2 which apparently claims the connector is received within the case side edge of said case and the connecting means is hidden within the case side edge of the case at a position below the upper edge of the case so as to pivotally connect the upper cover with the case. In fact, throughout the description and drawings of JP2001-165437, there is **no description of hinge hidden in the lighter case.** In order to achieve the main objective of JP2001-165437, there is nothing to do with the hidden hinge. Therefore, JP2001-165437 does not suggest any relationship the connecting means and the connector and how to receive the connecting means in the case side edge of the case. In other words, it is a totally different conception between JP2001-165437 and the instant invention, as shown in Attachment 2.

In claim 3 of the instant invention, two longitudinal grooves indently formed along two sidewalls of the edge port to receive the connecting means between the two longitudinal grooves, and two sidewalls of the connector are extended inclinedly and fittingly engage with the longitudinal grooves of the edge port.

In claims 5 and 6 of the instant invention, a bolt is slidably inserted into the transverse hole through the hole of the protuberance to pivotally connect the protuberance of the upper cover to the connector at the recess portion thereof, wherein the bolt has a diameter smaller than the thickness of the case side edge of the case such that the bolt is hidden within the case side edge when the connector is inserted into the edge port.

In claims 9, 10, 12 and 13 of the instant invention, the thickness of the case side edge is larger than the thickness of the connector. Therefore, when the connector is inserted into the edge port of the case, the connecting means is hidden within the case side edge of the case. In other words, the connecting means cannot be seen between the opened position and the closed position of the upper cover.

The JP2001-165437 **does not** suggest any groove to receive the hinge therein, while the JP2001-165437 merely anticipate two side portions of the sheet member are received in the grooves respectively. In addition, JP2001-165437 fails to teach and anticipate the hinge is positioned within the lower case at a position between the grooves.

In view of above, the JP2001-165437 and the instant invention are not the same invention and throughout the disclosure of the JP2001-165437, there is no suggestion to anticipate the arrangement of inserting the connector into the edge port of the case to hidden the connecting means within the case side edge of the case. Accordingly, applicants believe that the rejection of claim 2-21 is improper and should be withdrawn.

Response to Rejection of Claims 4, 7, 8, 11, 14-18, 20 and 21 under 35USC103

The Examiner rejected claims 4, 7, 8, 11, 14-18, 20 and 21 over JP2001-165437 in view of Newton (US 3,615,035). Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and JP2001-165437 which is qualified as prior art of the instant invention under 35USC102(a) are obvious in view of Newton at the time the invention was made to a person having ordinary skill in the art to which the subject

matter pertains. As alleged above, the differences between the invention as claimed in the instant invention and JP2001-165437 is that JP2001-165437 discloses the use of two sheet members inserted into the upper and lower cases to pivotally connect the upper case with the lower case while the instant invention suggests the use of connector to insert into the edge port to hidden the bolt within the case side edge of the case so as to pivotally connect the upper cover with the case.

Newton, on the other hand, describes a hinge unit comprising a pair of leaves 5 wherein each hinge leaf 5 comprises a tongue presenting a dovetailed configuration. However, Newton fails to suggest the hinge unit is hidden in the container. In fact, Newton shows the hinge unit provided on an exterior side of the container, as shown in Attachment 2. Therefore, there is no cited art to illustrate any suggestion or possibility of hiding the connecting means in the case side edge of the case by inserting the connector into the edge port of the case. In other words, there is no suggestion of any combination of cited arts for the obviousness of the subject matter sought to be patent as a whole in the instant invention.

Furthermore, the Examiner alleges that the thickness of the connector can be viewed as nothing more than a mere matter of choice in design. However, the lighter should take the thickness of the connector into account because the thickness of the case side edge, the diameter of the bolt, and the size of the hole at the protuberance are considered by the thickness of the connector. Also, the thickness of the connector will affect the size of the lighter and the strength of the pivot connection between the upper cover and the case.

The Examiner appears to reason that since JP2001-165437 teaches that two sheet members are inserted into the upper and lower cases to pivotally connect the upper case with the lower case, it would have been obvious to one skilled in the art to modify the hinge connecting portions to have a dovetail shape. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the

desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

In any case, even combining JP2001-165437 and Newton would not provide the invention as claimed -- a clear indicia of nonobviousness. *Ex parte Schwartz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). That is, modifying JP2001-165437 with Newton, as proposed by the Examiner, would not provide a hinge configuration having a connector received within the case side edge of said case and the connecting means hidden within the case side edge of the case at a position below the upper edge of the case so as to pivotally connect the upper cover with the case.

Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

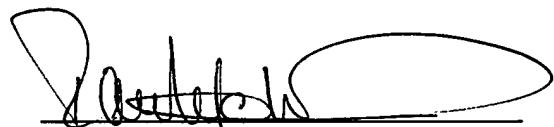
The Cited but Non-Applied References

The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 2-18 at an early date is solicited.

Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

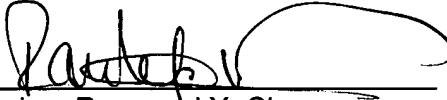


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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: March 17, 2005

Signature: 
Person Signing: Raymond Y. Chan